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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
ROSWELL, MICHAEL	

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/916,391	DAVIS, KENNETH L.	
	Examiner	Art Unit	
	Michael Roswell	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Microsoft Windows NetMeeting 3", copyright date 1999, as shown at http://www.microsoft.com/windows/NetMeeting/Corp/reskit/Copyright/default.asp, and supported by http://www.microsoft.com/windows/NetMeeting/Features/default.ASP, hereinafter NetMeeting, and "Markup File for Asynchronized Collaboration on an Image Viewer Application" by International Business Machines Corporation, hereinafter IBM.

Regarding claims 1 and 20, NetMeeting teaches receiving, in a first client, an identification of a second client to initiate a chat session with, initializing a chat session across a network between the first client and the second client, displaying a graphical image on the first client (all taught as part of the video and audio conferencing capabilities of NetMeeting, on page 2 and the chat feature of page 3), selecting a command to markup the graphical image (taught as the use of selectable drawing tools on a shared Whiteboard, on page 4), and transmitting the markup file across the network to the second client through the chat session (inherent to the program to allow users at different workstations to view edits to the graphical images).

NetMeeting does not explicitly teach in response to the command, storing markup information in a markup file separate from the graphical image, wherein the markup information comprises a markup entity, a source reference that identifies the graphical image, and an

orientation that indicates how the graphical image should be displayed with regard to the markup entity.

IBM teaches the use of a markup file for use on an image viewer application, such as the Whiteboard of NetMeeting. Furthermore, IBM shows storing markup information in a markup file separate from the graphical image (the script file of page 2), wherein the markup information comprises a markup entity (the markup information of page 2), a source reference that identifies the graphical image (inherent in the markup script data of page 2), and an orientation that indicates how the graphical image should be displayed with regard to the markup entity (the markup script information such as coordinates, rotation, and scaling of page 2).

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of NetMeeting and IBM before him at the time the invention was made to modify the chat and Whiteboard portions of the NetMeeting application to include the markup file capability of IBM in order to obtain a chat and image conferencing system where image markup may be stored separately from the original image.

One would be motivated to make such a combination for the obvious advantage of storing image markup separately from the original image.

Regarding claims 2 and 21, NetMeeting teaches storing the graphical image local to the second client, taught as the ability of NetMeeting users to save Whiteboard contents, at page 4.

Regarding claims 3 and 22, it can be seen in the NetMeeting image of page 4 that image markup commands are selectable from a menu.

Regarding claims 4 and 23, NetMeeting allows for a markup entity to be a second graphical image, taught as the ability to cut, copy, and paste information from any Windows-based application into the Whiteboard, at page 4.

Regarding claims 5 and 24, it can be seen in the NetMeeting image of page 4 that the markup entity may contain text.

Regarding claims 6 and 25, NetMeeting and IBM do not explicitly teach the use of XML for conveying markup information. However, XML files are well known in the art to give a user the flexibility of tag customization for specific information. The Examiner takes OFFICIAL NOTICE of this teaching. Therefore, it would have been obvious to one of ordinary skill in the art to include markup information in XML for the advantage of the flexibility offered by the language.

Regarding claims 7, 8, 26 and 27, it can be seen at NetMeeting page 3 that a single user or multiple users may be specified as the second client in contact with a first client.

Regarding claims 9 and 28, applicant's specification points to XML or other document definition languages as being "firewall friendly" and therefore provide for the transmission of a markup file and text across a network without breaching firewall security measures. Markup information in XML is taught *supra*, and thus provides for the transmission of a markup file and text across a network without breaching firewall security measures.

Regarding claims 10 and 29, the chat feature of NetMeeting (page 3) discloses functionality similar to an instant messaging application, such as the selection of a user or users to send messages to, and the ability to send private messages.

Regarding claim 11, NetMeeting inherently teaches a first client computer and a display device connected to the first client computer. Furthermore, any modern-day computer with storage means is capable of storing a graphical image. NetMeeting shows an instant messaging application installed on a first client computer (the chat capabilities of page 3) and allows for a selectable command to markup a graphical image (the Whiteboard of page 4). Through the use of such chat and Whiteboard capabilities, NetMeeting allows for receiving an identification of a second client to receive the markup file, initializing a chat session across a network with the second client, transmitting the markup file across the network to the second client through the chat session, and displaying the markup entity in the orientation on the graphical image on the display device.

NetMeeting fails to explicitly teach in response to the command, storing markup information in a markup file stored separately from the graphical image, wherein the markup information comprises a markup entity, a source reference that identifies the graphical image, and an orientation that indicates how the graphical image should be displayed with regard to the markup entity.

IBM teaches the use of a markup file for use on an image viewer application, such as the Whiteboard of NetMeeting. Furthermore, IBM shows storing markup information in a markup file separate from the graphical image (the script file of page 2), wherein the markup information comprises a markup entity (the markup information of page 2), a source reference that identifies the graphical image (inherent in the markup script data of page 2), and an orientation that

indicates how the graphical image should be displayed with regard to the markup entity (the markup script information such as coordinates, rotation, and scaling of page 2).

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of NetMeeting and IBM before him at the time the invention was made to modify the chat and Whiteboard portions of the NetMeeting application to include the markup file capability of IBM in order to obtain a chat and image conferencing system where image markup may be stored separately from the original image.

One would be motivated to make such a combination for the obvious advantage of storing image markup separately from the original image.

Regarding claim 12, NetMeeting shows the instant messaging application configured to display the markup file in the orientation on the graphical image on
the display device in response to receiving the markup file during the chat session, shown as the use of the Whiteboard application between multiple participants, at page 4.

Regarding claim 13, it can be seen in the NetMeeting image of page 4 that image markup commands are selectable from a menu.

Regarding claim 14, NetMeeting allows for a markup entity to be a second graphical image, taught as the ability to cut, copy, and paste information from any Windows-based application into the Whiteboard, at page 4.

Regarding claim 15, it can be seen in the NetMeeting image of page 4 that the markup entity may contain text.

Regarding claim 16, NetMeeting and IBM do not explicitly teach the use of XML for conveying markup information. However, XML files are well known in the art to give a user the flexibility of tag customization for specific information. The Examiner takes OFFICIAL NOTICE of this teaching. Therefore, it would have been obvious to one of ordinary skill in the art to include markup information in XML for the advantage of the flexibility offered by the language. See "What is XML?" by Norman Walsh, at http://www.xml.com/pub/a/98/10/guide1.html#AEN78.

Regarding claims 17 and 18, it can be seen at NetMeeting page 3 that a single user or multiple users may be specified as the second client in contact with a first client.

Regarding claim 19, applicant's specification points to XML or other document definition languages as being "firewall friendly" and therefore provide for the transmission of a markup file and text across a network without breaching firewall security measures. Markup information in XML is taught *supra*, and thus provides for the transmission of a markup file and text across a network without breaching firewall security measures.

Response to Arguments

The document entitled "Resource Kit Copyright Information", last updated 15 December 1999, (http://www.microsoft.com/windows/NetMeeting/Corp/reskit/Copyright/default.asp), demonstrates a copyright date for NetMeeting version 3 of 1999, which clearly predates the filing date of the application. The document demonstrating the features found in NetMeeting 3 (http://www.microsoft.com/windows/NetMeeting/Features/default.ASP), provided in the Office Action dated 1 June 2004, is relied upon as a supporting document, and as such benefits from

the copyright date disclosed in the document entitled "Resource Kit Copyright Information". Due to the fact that the grounds of rejection have not changed, this action is made FINAL.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Roswell whose telephone number is (571) 272-4055. The examiner can normally be reached on 8:30 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Roswell
3/2/2005

JOHN CABECA
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